



Attorney Docket No.: 97-106 CIP
Serial No.: 09/145,690

#79
263

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Charles J. Long, Jr.)
)
Serial No.: 09/145,690)
)
Filed: September 2, 1998)
)
Group Art Unit: 3727)
)
Examiner: Hylton, Robin/Cronin, Stephen)
)
Our Ref: 97-106 CIP)

**SNAP-ON SCREW-OFF
CLOSURE**

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February 2, 2001

Commissioner of Patents and Trademarks
Washington DC 20231

Sir/Madam:

SUPPLEMENTAL APPEAL BRIEF

Pursuant to 37 C.F.R. §§ 1.191 and 1.192, the Applicants hereby submit the following SUPPLEMENTAL APPEAL BRIEF to the U.S. Patent and Trademark Office ("PTO") Board of Appeals and Interferences, in appeal of the Examiner's decision to finally reject Claims 1-25 of U.S. Patent Application Serial No. 09/145,690.

Submitted herewith is a RENEWED PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. 1.181 FOR ENTRY OF AMENDMENT AFTER FINAL REJECTION; AND REQUEST FOR RECONSIDERATION PURSUANT TO 37 C.F.R. 1.116 (the "Renewed Petition"), which is based on the refusal of the Examiner to enter the AMENDMENT filed by Applicant on July 6, 2000 (appended to the Renewed Petition as Exhibit

"D"), which was the subject of the PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. 1.181 FOR ENTRY OF AMENDMENT AFTER FINAL REJECTION; AND REQUEST FOR RECONSIDERATION PURSUANT TO 37 C.F.R. 1.116 (the "Original Petition") filed August 18, 2001. As explained in the Renewed Petition, in the Response Supplemental to Decision filed on October 11, 2000 (appended to the Renewed Petition as Exhibit "C"), the Examiner refused to comply with the Decision on Petition entered on September 18, 2000 (appended to the Renewed Petition as Exhibit "B"), which disposed of the Original Petition by stating as follows:

It appears to the undersigned that in this application, it would be appropriate to have the examiner reconsider the refusal to enter the amendment, and, if such refusal is still deemed proper, *to have the record reflect the examiner's rationale in light of the arguments presented in the petition.*¹

In the Response Supplemental to Decision, the Examiner did not provide any rationale, or other information whatsoever, to support his refusal to enter the AMENDMENT, other than merely repeating essentially verbatim the same comments made in the Advisory Action filed July 21, 2000 (appended to the Renewed Petition as Exhibit "A") without providing any evidence and/or argument whatsoever to address the points made in the Original Petition, which served as the basis for the conclusion in the Decision on Petition that the Examiner should reconsider his refusal to enter the AMENDMENT. As a result, the Renewed Petition has been filed seeking entry of the AMENDMENT.

In order to comply with the Notification Of Non-Compliance With The Requirements Of 37 CFR 1.192(c) filed January 2, 2001, this SUPPLEMENTAL APPEAL BRIEF is being filed to

eliminate the material contained under the heading "**Entry of Amendment Dated July 6, 2000**" in the original APPEAL BRIEF filed October 18, 2000. If the Renewed Petition should be granted and the AMENDMENT is entered, Applicant respectfully reserves the right, and hereby petitions, for reinstatement of the material contained under the heading "**Entry of Amendment Dated July 6, 2000**" in the original APPEAL BRIEF.

¹ See Decision on Petition; appended as Exhibit "B" to Renewed Petition.

I.
Real Party In Interest

The real party in interest is International Plastics and Equipment Corporation, which is the assignee of U.S. Patent Application Serial No. 09/145,690.

II.
Related Appeals and Interferences

There are no related Appeals or Interferences.

III.
Status of Claims

Claims 1-25 are currently pending in U.S. Patent Application Serial No. 09/145,690:

1. Claims 1-25 were finally rejected and are on appeal:

(a). Claims 7, 8, 10, 12, 15, 16, 18 and 20 as dependent from Claim 1 are indefinite under 35 U.S.C. § 112, ¶2 in claiming an improper combination/subcombination.

(b). Claims 1 and 25 have been rejected under 35 U.S.C. § 102 as being anticipated by Molinaro, U.S. Patent No. 5,480,045.

(c). Claims 11, 13 and 14 have been rejected under 35 U.S.C. § 103 as being obvious in light of Molinaro in combination with Montgomery, U.S. Patent No. 5,379,610.

(d). Claims 1-6, 21, 22 and 25 have been rejected under 35 U.S.C. § 103 as being obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 and Sander,

U.S. Patent No. 5,487,481.

(e). Claim 9 has been rejected under 35 U.S.C. § 103 as being obvious in light of the prior art as applied to Claim 1 or 25, and further in view of Csaszar, U.S. Patent No. 4,343,408.

(f). Claims 11, 13 and 14 have been rejected under 35 U.S.C. § 103 as being obvious in light of the prior art as applied to Claim 1, 11/1 or 11/25, and further in view of Montgomery.

(g). Claims 17 and 19 have been rejected under 35 U.S.C. § 103 as being obvious in light of the prior art as applied to Claim 1 or 25, and further in view of Repp, U.S. Patent No. 5,593,055.

(h). Claims 1, 21 and 23-25 have been rejected under 35 U.S.C. § 103 as being obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675.

2. Claim 7 as dependent from Claim 1 and Claims 8, 10, 12, 15, 16, 18 and 20 as dependent from Claims 6/4/3/2/1 and Claims 6/4/3/2/25 and the preceding claim dependent thereon (i.e., Claim 10 as dependent from Claims 8/6/4/3/2/1 and from Claims 8/6/4/3/2/25) were indicated to be allowable over the prior art if rewritten to overcome the 35 U.S.C. § 112, ¶2 rejections and to include the limitations of the base claim and any intervening claims.

IV.

Status of Amendments

In the Amendment dated July 6, 2000, Claims 1, 7 and 8 were amended to overcome the 35 U.S.C. § 112, ¶2 rejection posed in the Final Office Action, while Claims 1, 22 and 25 were amended to incorporate the limitations of Claims 21, 23 and 24, which were cancelled. Entry of these amendments was refused in an Advisory Action issued in response to the aforesaid Amendment on July 21, 2000. On August 18, 2000, Applicant filed a Petition to the Commissioner for entry of the aforesaid Amendment, which was forwarded to the Examiner for consideration in the Decision on Petition dated September 18, 2000. Entry of the Amendment was again refused in the Response Supplemental to Decision filed by the Examiner on October 11, 2000.

For the purposes of this appeal, the Affidavits of Charles J. Long, Jr. and Dieter Sander Pursuant to 37 C.F.R. § 1.132, which accompany the Amendment filed February 4, 2000, were admitted into evidence.

V. Summary of the Invention

The present invention provides a closure with a thread configuration adapted for snap-on or screw-on application to a container neck finish. Preferably the closure and neck finish contain eight or nine mating continuous or discontinuous threads for this purpose. (See specification; at Figs. 1 and 1A; and at page 8, lines 8-15; and at page 11, lines 8-15; and at page 12, lines 15-20.)

The present invention preferably provides at least one annular sealing bead depending from the outer surface of the closure valve which are compressed against the inner surface of the container neck to form a seal as the closure is snapped onto the container neck. Optionally,

sealing engagement between the closure and the mating portions of the exterior wall of the container neck may be further improved by including one or more annular sealing beads on the interior surface of the closure depending annular skirt. (See specification; at Fig. 3; and at page 11, line 16 through page 12, line 14.)

The present invention also preferably provides a plurality of elevated areas extending upwardly from the tamper-evident band in spaced relation to the bottom edge of the closure body to support the tamper evident band in resisting vertical movement imparted by insertion of the closure on the bottle neck, thereby protecting the frangible elements during assembly. The frangible elements connecting the tamper-evident band to the lower edge of the closure body may be configured to extend from these elevated areas as well as the non-elevated areas of the tamper-evident band to assist in preventing axial misalignment of the tamper-evident band relative to the annular depending skirt portion of the closure upon subjecting the closure to torquing forces during assembly to the container neck. (See specification, at Figs. 1A, 2 and 2A; and at page 9, lines 1-15.)

Additionally, the tamper indicating closure may include at least one arcuate projection extending around at least a portion of the tamper indicating ring arranged for registration with an annular locking flange on a container neck portion on which the closure is positioned. The closure is optionally provided with at least one member attached to the tamper-indicating ring which cooperates with the arcuate projection to assist in breaking the tamper indicating ring during removal of the closure from the container neck. The arcuate projection is held in place by the container neck as the member is pulled away from the arcuate projection during twist-off removal of the closure body to cause the tamper indicating ring to break at a weakened area. (See

specification; at Figs. 4 and 5; and at page 9, line 16 through page 11, line 7.)

At least one and preferably a plurality of circumferentially spaced lugs optionally extend from the exterior wall of the container neck to facilitate breaking the frangible elements on the tamper-evident band of the closure by engaging the frangible elements as the closure is twisted off the container neck following initial snap-on application. (See specification, at Figs. 1 and 1A; and at page 8, lines 1-7.)

Formal drawings corresponding to those filed in International Application Serial No. PCT/US98/22933 are being submitted herewith in Appendix "B" for the purpose of aiding in an understanding of the invention.

VI.

Issues

- (a). Whether Claims 7, 8, 10, 12, 15, 16, 18 and 20 as dependent from Claim 1 are indefinite in claiming an improper combination/subcombination.
- (b). Whether Claims 1 and 25 are anticipated by Molinaro, U.S. Patent No. 5,480,045.
- (c). Whether Claims 11, 13 and 14 are obvious in light of Molinaro in combination with Montgomery, U.S. Patent No. 5,379,910.
- (d). Whether Claims 1-6, 21, 22 and 25 are obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 and Sander, U.S. Patent No. 5,487,481.
- (e). Whether Claim 9 is obvious in light of the prior art as applied to Claim 1 or 25, and further in view of Csaszar, U.S. Patent No. 4,343,408.

(f). Whether Claims 11, 13 and 14 are obvious in light of the prior art as applied to Claim 1, 11/1 or 11/25, and further in view of Montgomery.

(g). Whether Claims 17 and 19 are obvious in light of the prior art as applied to Claim 1 or 25, and further in view of Repp, U.S. Patent No. 5,593,055.

(h). Whether Claims 1, 21 and 23-25 are obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675.

VII.

Grouping of Claims

For the reasons set forth below, Claims 1-25 are all product claims which stand independently of each other.

VIII.

Argument

The Examiner has replaced the original prior art rejections in the initial Office Action with rejections that all rely on references: Molinaro, U.S. Patent No. 5,480,045; Montgomery, U.S. Patent No. 5,738,231; Kern, U.S. Patent No. 4,448,319; Sander et al., U.S. Patent No. 5,487,481; Csaszar, U.S. Patent No. 4,343,408; Repp et al., U.S. Patent No. 5,593,055; and Julian, U.S. Patent No. 5,056,675. In the final Office Action, the Examiner has withdrawn all of the previous bases for rejection of the claims and now asserts that (i) Claims 1 and 25 are anticipated by Molinaro, U.S. Patent No. 5,480,045; (ii) Claims 1-6, 22 and 25 are obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 with Sander, U.S. Patent No.

5,487,481; (iii) Claim 9 is obvious in light of the prior art as applied to Claim 1 or 25 in combination with Csaszar, U.S. Patent No. 4,343,408; (iv) Claims 11, 13 and 14 are obvious in light of Molinaro or the prior art as applied to Claim 1, 11/1 or 11/25 in combination with Montgomery, U.S. Patent No. 5,379,910; (v) Claims 17 and 19 are obvious in light of the prior art as applied to Claim 1 or 25 in combination with Repp et al., U.S. Patent No. 5,593,055; and (vi) Claims 1, 21 and 23-25 are obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675. The Examiner has indicated that Claims 7, 8, 10, 12, 15, 16, 18 and 20 (as dependent from Claims 1 and 25) are allowable over the prior art and would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 and to include all of the limitations of base Claims 1 and 25 and any intervening claims.

It is respectfully submitted that all the claims are in a condition for allowance as being dependent upon Claims 1 and 25 which are allowable over the prior art of record.

-A-

1. Claim Rejections under 35 U.S.C. § 112

The Examiner has rejected Claims 7 and 8, and all other claims dependent on Claim 8 and Claim 1, for indefiniteness on the basis that the preamble of those claims is directed to a closure while the body of those claims positively introduces the projection structure of the container. Applicant respectfully traverses this rejection, on the basis that this method of claiming is perfectly acceptable as indicated by one of the cited prior art references, i.e.,

Molinaro, U.S. Patent No. 5,480,045, which claims a *"closure for use with a neck"* that recites features of the closure in cooperation with recited elements of the neck (i.e., *"...at least one second spiral thread configuration on said upper skirt portion shaped and positioned to slip past said at least one first spiral thread configuration and interengage when said closure is applied to said neck..."*) See Molinaro, U.S. Patent No. 5,480,045; at Claim 16.)

2. Claim Rejections under 35 U.S.C. §§ 102 and 103:

Molinaro, U.S. Patent No. 5,480,045, has been relied upon as the basis for an anticipation rejection of Claims 1 and 25 under 35 U.S.C. § 102 and as the basis for an obviousness rejection of Claims 9, 11, 13, 14, 17 and 19 under 35 U.S.C. § 103. (See Final Office Action dated 3/28/00; at ¶¶ 4, 5, 7, 8 and 9.) However, all rejections based on Molinaro cannot stand because that reference does not teach or suggest *"[a] tamper indicating closure configured for snap-on or screw-on application to a container, said closure comprising ... a tamper indicating ring connected to said depending skirt by a frangible element."* as required by all claims as dependent from Claims 1 and 25. Instead, Molinaro teaches a closure which **must be snapped** onto its container neck with the tamper indicating band **intact**. This is because of the presence of ratchet teeth **26** and **12** on the closure and container neck, respectively, which will not allow solely screw-on application of the closure with the tamper indicating band **25** intact. (See Molinaro; at Figs. 1-5 and at column 3, lines 55-67.) For the foregoing reasons, Molinaro is not an applicable reference and cannot be relied upon for properly rejecting Applicant's claims.² Moreover, even if

² See MPEP § 2141.01(a) ("in order to rely on a reference as a basis for rejection . . . the reference must . . . be in the field of applicant's endeavor or . . . reasonably pertinent to the

considered applicable, Molinaro cannot anticipate³ or render obvious⁴ Claim 1 or 25 or any other pending claim of the present application, which all depend therefrom.,⁵ for the same reasons.

Kern, U.S. Patent No. 4,448,319 has been cited in combination with Sander, U.S. Patent No. 5,487,481 as rendering Claims 1-6, 9, 11, 13, 14, 17, 19, 21, 22 and 25 obvious under 35 U.S.C. § 103(a). (See Final Office Action dated 3/28/00; at ¶¶6-9). However, as explained in Applicant's response to the Initial Office Action, any rejection based on Sander is inapplicable because it does not disclose a container closure system capable of permitting snap-on application

*problem with which the inventor was concerned"); see also MPEP § 904.01(c)(determination of analogous art "depends on the necessary **essential function** or utility of the subject matter **covered by the claims**"). See also Heidelberg Druckmaschinen AG v. Hantscho Commercial Products, 21 F.3d 1068, 1071-72 30 USPQ.2d 1377, 1379-80 (Fed. Cir. 1994)(holding relied-upon references did not support rejection of obviousness because the trial court "identified no reference that taught or suggested that [the elements of the claims] might be **adapted** to the [claimed combination] . . . when the patented invention is made by combining **known** components to achieve a **new** system, the prior art must provide a suggestion or motivation to make such a combination")(alteration in original).*

³ See MPEP § 2131 (citing In re Bond, 910 F.2d 831, 832 (Fed.Cir. 1990))(for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be **identically shown** in that reference, and the elements must be arranged as in the claim under review); In re Paulsen, 30 F.3d 1475, 1478-79 (Fed.Cir. 1994)(to serve as the basis for a 35 U.S.C. § 102 rejection, the relied upon reference must contain **all** the limitations of the rejected claim); PPG Industries v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ.2d 1618, 1624 (Fed.Cir. 1996)("[t]o anticipate a claim [under 35 U.S.C. § 102] a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter").

⁴ See Motorola v. Interdigital Technology Corp., 121 F.3d 1461, 1471, 43 USPQ.2d 1481, 1489 (Fed.Cir. 1997)("[i]n order to render a claimed apparatus or method obvious, the prior art must **enable** one skilled in the art to **make and use** the apparatus or method")(citing Beckman Instruments, Inc. v. Productter AB, 892 F.2d 1547, 1551, 13 USPQ.2d 1301, 1304 (Fed.Cir. 1989)).

⁵ See In re Fine, supra, 837 F.2d at 1076 (dependent claims are allowable if independent claims from which they depend are allowable).

of the closure to the container during initial installation as required by the instant claims.

Instead, this reference discloses a closure which can only be screwed onto a container and thus does not enable the requirement of Claims 1 and 25 (and the claims dependent therefrom) for *"said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck"*. (See Sander; at column 3, lines 10-26. See also Declaration of Dieter Sander, appended as Exhibit "A" to Applicant's Amendment dated February 4, 2000.) The Examiner has apparently agreed that, for this reason, Sander is not an appropriate basis for rejecting the claims, as all of the previously asserted claim rejections relying on Sander have been withdrawn. Thus, for the same reasons as discussed in Applicant's response to the Initial Office Action, Sander cannot render the finally rejected claims unpatentable either (see footnotes 1 and 3, supra)⁶ (See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(b).)

In addition, and contrary to the Examiner's assertion, Kern does not teach or enable a "snap-on" closure as claimed in the instant application to require *"an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration*

⁶ See MPEP § 2143.01 ("if the proposed modification or combination of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious"). See also In re Gordon, supra, 733 F.2d at 901-02 (reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that "if [the prior art reference were modified in the manner suggested] **it would be rendered inoperable for its intended purpose**. . . . In effect, [the relied-upon reference] **teaches away** from the board's proposed modification")(alteration in original).

*adapted for **engaging** an external thread configuration on the neck portion of said container by **snap-on** application during initial installation of said closure to said container neck".* The teachings of Kern clearly indicate that it cannot be completely installed by snap-on application. Instead, it only allows the threads of the closure to "*snap over the **first turn**" of the bottle threads "so that the **screw cap** takes up a proper level position and can be properly **tightened** on to the bottle or container"* by an additional screw-on action. (See Kern; at Abstract; and at col. 1, line 35 - col. 2, line 62). Moreover, Kern discloses that a gap 14 must exist in the screw-thread of the cap or it will not be possible to snap the cap onto the container. (See Kern; at col. 1, line 35 - col. 2, line 62; and at column 3, lines 25-63). For these reasons, Kern again cannot be installed without being threaded onto a container, and thus also does not teach or enable the claimed limitation requiring "*said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by **snap-on** application during initial installation of said closure to said container neck*". Thus, Kern is also inapplicable and cannot be relied upon to reject Claims 1-6, 9, 11, 13, 14, 17, 19, 21, 22 or 25, independent of the other bases for rejection of these claims or of each other. (see footnote 5, supra). (See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(d).)

Moreover, all claim rejections based on Csaszar (see col. 2, line 30-52; col. 4, line 53 - col. 5, line 13) and Montgomery (see col. 1, lines 23-35; col. 3, line 56 – col. 4, line 26); are improperly asserted for these same reasons, as these references teach a closure which is initially installed by screw on action instead of a snap-on procedure and thus do not teach or enable the claimed limitation requiring "*said depending skirt having an internal thread configuration*

*adapted for engaging an external thread configuration on the neck portion of said container by **snap-on application during initial installation** of said closure to said container neck". As a result, the rejection of Claims 9, 11, 13 and 14 cannot stand (independent of the rejection of Claims 1 and 25 from which they depend or of each other) because they are all based on the improper combination of Csaszar or Montgomery (or both) -- which are both initially threaded onto a container -- with one or more other references (see footnotes 1, 3 and 5 supra). (See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(c).)*

Repp teaches away from the requirement of all of Applicant's pending claims for "*a tamper indicating ring connected to said depending skirt by a frangible element*", by stating that "[t]he cap **21** may be very forcefully removed from the neck **22** **without first removing the lower skirt 65** by unscrewing the cap. . . . Hence, if the cap is screwed back on the neck, the fact that bridges **67** have been fractured may not be readily apparent. Alternatively, the lower skirt **65** may be removed from the cap **21** **before** the cap is twisted open. . . . The tear tab [**74**] provides means for removing the lower skirt" (See Repp; at column 6, line 62 through column 7, line 11)(alteration in original). Thus, Repp teaches that lower skirt **65** may not be removed merely by "screw-off" action of the closure with respect to the container neck as is made possible by the "frangible element(s)" of Applicant's claimed invention. Instead, a tear tab 74 must first be used to tear the lower skirt **65** away from the closure instead of being removed by a screw-off action. The claimed invention operates under none of these constraints,, as a result the obviousness

rejections of Claims 17 and 19 based on Repp cannot stand, independent of the other rejections.⁷

(See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(a).)

Moreover, Claims 21, 23 and 24 are patentable independent of the other claims, due to limitations that require:

21. The tamper indicating closure of Claim 1 or 25, wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned.

23. The tamper indicating closure of Claim 21, wherein said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.

24. The tamper indicating closure of Claim 23, wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate

⁷ See W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1552-53 (Fed.Cir. 1983)(*"proceeding contrary to [i.e., "teaching away" from] the accepted wisdom in the art . . . is "strong evidence of nonobviousness"*); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578-80, 42 USPQ.2d 1378, 1383-84 (Fed.Cir. 1997)(same). See also In re Gordon, 733 F.2d 900, 901-02, 221 USPQ 1125 (Fed.Cir. 1984)(reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that *"[the relied-upon reference] teaches away from the board's proposed modification"*)(alteration in original); In re Fine, 837 F.2d 1071, 1074-76, 5 USPQ.2d 1596 (Fed.Cir. 1988)(same).

projection.

The only basis for rejection of Claims 23 and 24 was the combination of Kern and Julian, where Julian was cited as disclosing the foregoing limitation added to Claims 1 and 25. Notwithstanding the inapplicability of Kern to the present claims for the reasons set forth above, Julian does not disclose a tamper indicating band having the claimed "*arcuate projection*", but instead teaches only ratchet teeth **52** that do not allow rupture of the tamper indicating band in a manner equivalent to the claimed requirement that "*said arcuate projection is held in place by an **annular locking flange** on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring **upward** to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection*".

Instead of allowing movement of the tamper indicating ring "**upward** to cause breakage of said frangible elements and fracture of said weakened area" as required by the instant claims, the ratchet teeth **52** cause the tamper evident band to stay stationary as breakage of the band occurs by circumferential (and not upward) movement of the main body of the closure to sever frangible elements **34/34'** and **50/50'** as shown in Figs. 4-7 of Julian:

Likewise, in the unthreading direction, the stop surfaces **54** of the band ratchet teeth **52** will engage the stop surfaces **60** of the container neck ratchet teeth **58** to prevent further rotation of the tamper indicating band **30** relative to the container **24**.... Referring to Fig. 4 as the cap **12** is further turned in the unthreading direction

after the band ratchet teeth **52** have engaged the container neck ratchet teeth **58**, the band **30** *will remain stationary* with respect to the container neck, but the cap will *turn* relative to the band ... until the axially extending frangible webs **34** will become fractured as shown at **34'**.... Continuing rotation in the direction of the arrow as shown in Fig. 5 will further flex the permanent flexible web **36** so that [t]he circumferentially extending frangible webs **50** will now be put under fracturing tension so that additional *rotation* of the cap in the direction of the arrow as shown in Fig. 6 will fracture these webs as shown at **50'**. (See Julian; at column 5, lines 5-68; and at Figs.4-7.)

As with the prior withdrawn rejection of original Claims 21-24 based on Beck, U.S. Patent No. 5,215,204, permanent flexible web **36** in Julian does not assist in breaking tamper indicating ring **30** by pulling the tamper indicating ring upward. This distinction over Beck as drawn in Applicant's response to the Initial Office Action was accepted as a basis for withdrawing the rejection, and applies equally to overcome the present obviousness rejection based on Julian (see footnotes 2, 4 and 6, supra). Moreover, this distinction would apply to render Claims 21, 23 and 24 patentable independent of the other claims. Id.

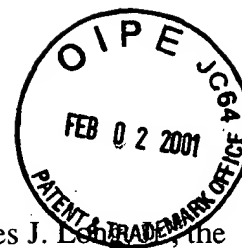
In summary, the Examiner as a matter of law has not provided sufficient evidence to support his burden of establishing a *prima facie* case of unpatentability. Instead, in relying purely on his own opinion to draw the conclusion that the claimed features would have been anticipated or obvious in light of the cited references without providing evidence in the prior art to support that conclusion -- especially evidence contained within the disclosure itself of any of these references (i.e., by reference with particularity to relevant portions of the description showing that the modifications necessary to arrive at the claimed invention starting from these teachings would be desirable or could even be accomplished) -- the Examiner has engaged in the type of "hindsight reconstruction" that is an impermissible basis for establishing anticipation or

obviousness.⁸ The DECISION ON APPEAL dated January 22, 2001 (appended hereto as Exhibit "1") is a recent decision from the Board of Patent Appeals and Interferences, in a case appealed by the undersigned, which addresses this precise issue and supports the position being advanced by Applicant here:

... [T]he examiner has a duty to specify the prior art relied on and to describe *where* in the prior art there is a teaching or suggestion of the claimed features. *The examiner may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in*

⁸ See MPEP § 2142 ("[w]ith regard to rejections under 35 U.S.C. § 103, **the examiner must provide evidence** which as a whole shows . . . [that] the reference teachings establish a prima facie case of obviousness"); MPEP § 2143.01 ("a statement that modifications of the prior art to meet the claimed invention would have been '**well within the ordinary skill of the art**' at the time the claimed invention was made . . . is **not** sufficient to establish a prima facie case of obviousness without some objective **reason** to combine teachings of the references")(citing Ex parte Levengood, 28 USPQ.2d 1300)(Bd.Pat.App.&Inter. 1993)("As adapted to ex parte procedure, Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)) has been interpreted as continuing to place the burden of proof on the Patent Office which requires it to produce the factual basis for [its] rejection of an application under 35 U.S.C. § 102 or 103. . . . [A]n examiner **cannot** establish obviousness by locating references which describe various aspects of a patent applicant's invention **without also providing evidence of the motivating force** which would impel one skilled in the art to do what the patent applicant has done" (alteration in original))(also citing In re Fine, supra, 837 F.2d at 1074-76 ("[t]he relied-upon references] disclose at most, that one skilled in the art might find it **obvious to try** the claimed invention. But whether a particular combination might be 'obvious to try' is **not** a legitimate test of patentability. The Examiner relies on hindsight to reach his obviousness determination. But this court has said '[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher'")(citing W.L. Gore & Associates v. Garlock, Inc., supra). See also In re Laskowski, 871 F.2d 115, 116, 10 USPQ.2d 1397, 1398 (Fed.Cir. 1989)(reversing Board of Appeals and Interferences affirmance of rejection based on obviousness since "the mere fact that the prior art **could** be so modified would **not** [make] the modification obvious unless the prior art suggested the **desirability** of the modification"); In re Fritch, 972 F.2d 1260, 1265-66, 23 USPQ.2d 1780 (Fed.Cir. 1992)(same). See also In Re Bond, 910 F.2d 831, 834-35, 15 USPQ.2d 1566 (Fed.Cir. 1990) (rejecting a Board of Appeals and Interferences finding of obviousness where "critical differences exist between the claimed invention and the [relied-upon] prior art")(alteration in original).

*the factual basis.*⁹ (alteration in original, citations omitted)

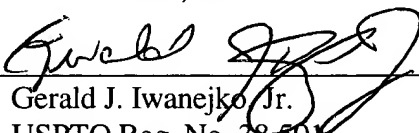


In the Amendment dated February 4, 2000, the Declaration of Charles J. Long, the inventor in the present application and an officer of the assignee, was entered as evidence of the unobviousness of the claimed invention pursuant to 37 C.F.R. § 1.132. The Examiner has not challenged the factual basis for any of the statements in the affidavit, a fact which requires allowance of the claims, because the evidence of unobviousness supplied by the affidavit is uncontroverted by any other proof in the record from one of skill in the art.

For the foregoing reasons, Applicants submit that the present invention is not anticipated or obviated by the teachings of the prior art, and that the patent application and of Claims 1-25 therein are in a condition for allowance. Reversal of the rejection is, therefore, respectfully requested.

Respectfully submitted,
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By: _____


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⁹ See DECISION ON APPEAL, entered in U.S. Patent Application Serial No. 08/707,272, dated January 22, 2001 (appended hereto as Exhibit "1").

IX.
Appendix "A"

WHAT IS CLAIMED IS:

1. A tamper indicating closure configured for snap-on or screw-on application to a container, said closure comprising:

- a. a closure top portion;
- b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;
- c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and
- d. a tamper indicating ring connected to said depending skirt by a frangible element.

2. The tamper indicating closure of Claim 1 or 25, wherein said tamper indicating ring includes an elevated area extending axially towards said depending skirt, wherein said elevated area defines a region of decreased ring spacing from said depending skirt.

3. The tamper indicating closure of Claim 2, further comprising a plurality of said frangible elements and said elevated areas, wherein at least one of said frangible elements is connected to said depending skirt between two said elevated areas.

4. The tamper indicating closure of Claim 3, wherein at least one other said frangible element is connected to said depending skirt from an elevated area.

5. The tamper indicating closure of Claim 3 wherein said elevated areas extending from said tamper indicating ring are of a known vertical height, and said frangible elements are of a height greater than that of said known height of said elevated areas.

6. The tamper indicating closure of Claim 4 wherein said elevated areas extending from said tamper indicating ring are of a known vertical height, and said frangible elements are of a height greater than that of said known height of said elevated areas.

7 The tamper indicating closure of Claim 1 or 25, wherein said container neck additionally comprises a projection configured for engaging said frangible element to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

8. The tamper indicating closure of Claim 6, wherein said container neck contains at least one projection configured for engaging said frangible elements to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

9 The tamper indicating closure of Claim 1 or 25, wherein said inner annular sealing flange includes at least one annular sealing bead extending around a portion of said inner annular sealing flange and being configured for engagement with the interior surface of said container neck finish.

10. The tamper indicating closure of Claim 8, wherein said inner annular sealing flange includes at least one annular sealing bead extending around a portion of said inner annular sealing flange and being configured for engagement with the interior surface of said container neck finish.

11 The tamper indicating closure of Claim 1 or 25, wherein said annular depending

skirt includes at least one annular sealing bead extending around a portion of said skirt and being configured for engagement with the exterior surface of said container neck finish.

12 The tamper indicating closure of Claim 10, wherein said annular depending skirt includes at least one annular sealing bead extending around a portion of said skirt and being configured for engagement with the exterior surface of said container neck finish.

13. The tamper indicating closure of Claim 11, wherein at least one said annular sealing bead engages a sealing bead on the exterior of said container neck finish.

14 The tamper indicating closure of Claim 11, wherein at least one said annular sealing bead engages a sealing groove on the exterior of said container neck finish.

15. The tamper indicating closure of Claim 12, wherein at least one said annular sealing bead engages a sealing bead on the exterior of said container neck finish.

16. The tamper indicating closure of Claim 12, wherein at least one said annular sealing bead engages a sealing groove on the exterior of said container neck finish.

17. The tamper indicating closure of Claim 1 or 25, wherein said thread configurations contain eight or nine circumferentially spaced individual thread leads.

18. The tamper indicating closure of Claim 12, wherein said thread configurations contain eight or nine circumferentially spaced individual thread leads.

19. The tamper indicating closure of Claim 17, wherein said thread leads are segmented.

20. The tamper indicating closure of Claim 18, wherein said thread leads are segmented.

21. The tamper indicating closure of Claim 1 or 25, wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is

positioned.

22. The tamper indicating closure of Claim 21, wherein at least one said arcuate projection comprises a locking member extending radially inward from said tamper indicating ring at an angle to a plane normal with said tamper indicating ring.

23. The tamper indicating closure of Claim 21, wherein said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.

24. The tamper indicating closure of Claim 23, wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection.

25. A tamper indicating closure configured for snap-on or screw-on application to a container, said closure and container comprising in combination:

- a. a closure top portion;
- b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;

- c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and
- d. a tamper indicating ring connected to said depending skirt by a frangible element.

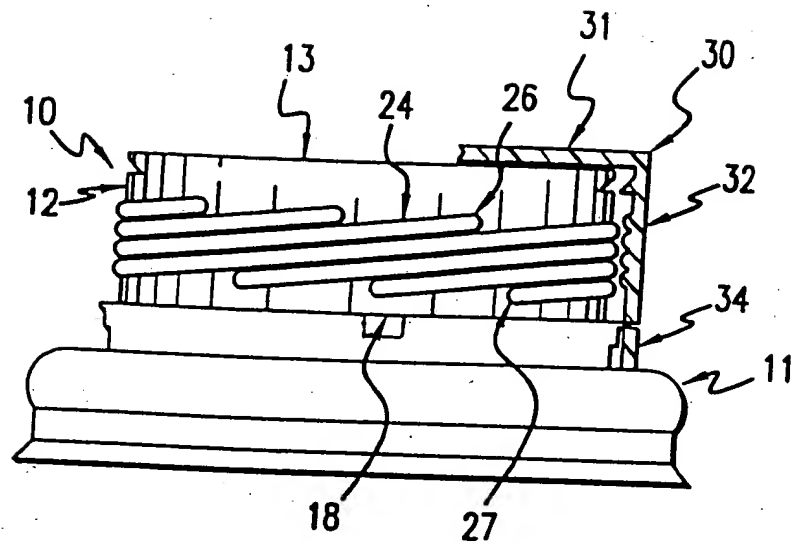


FIG. 1

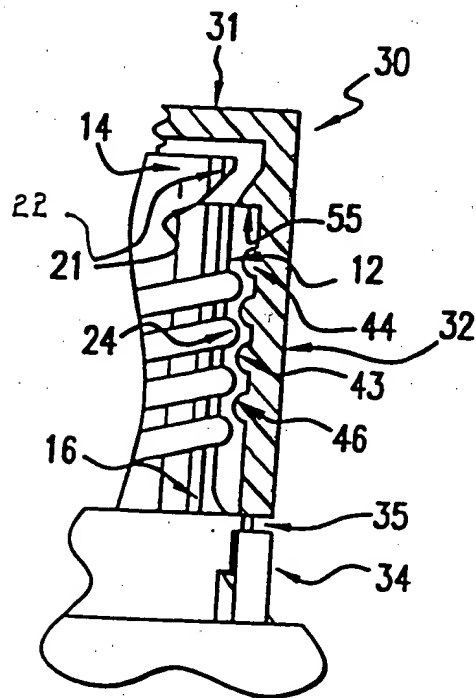


FIG. 1A

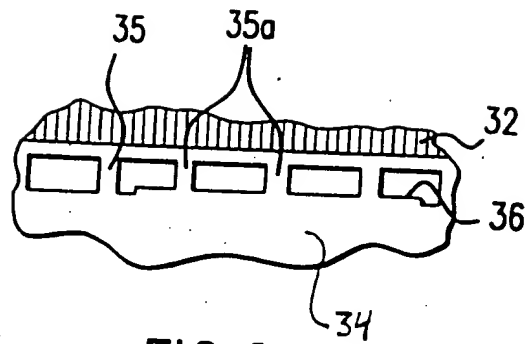


FIG. 2

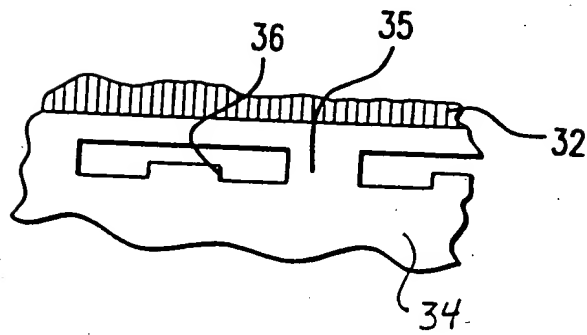
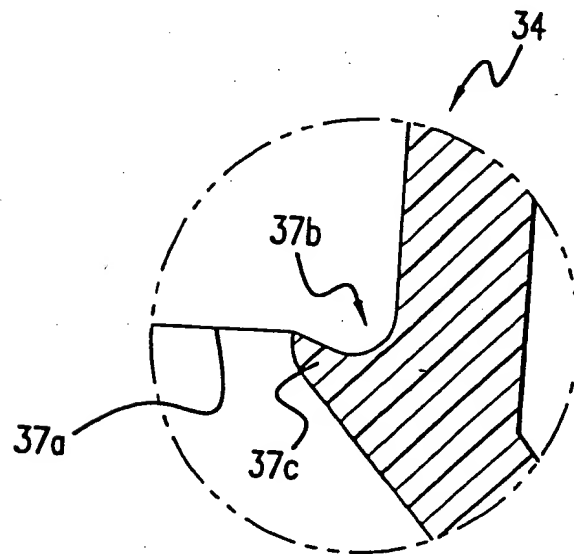
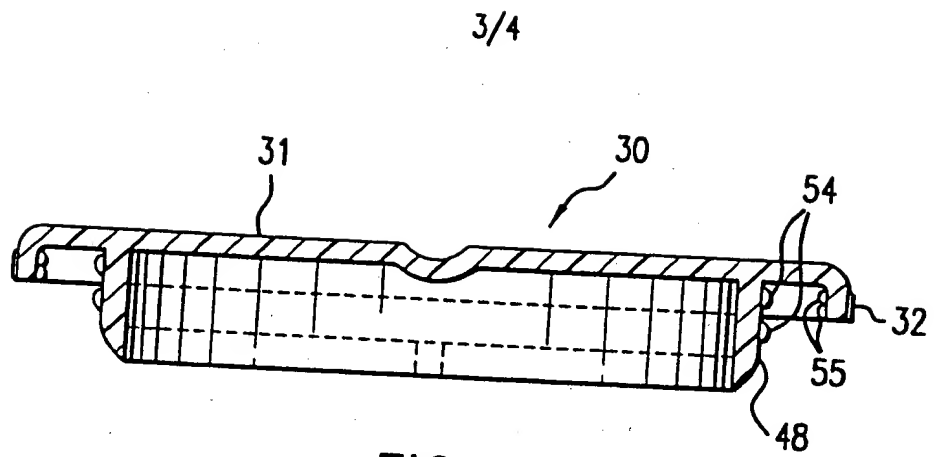


FIG. 2A



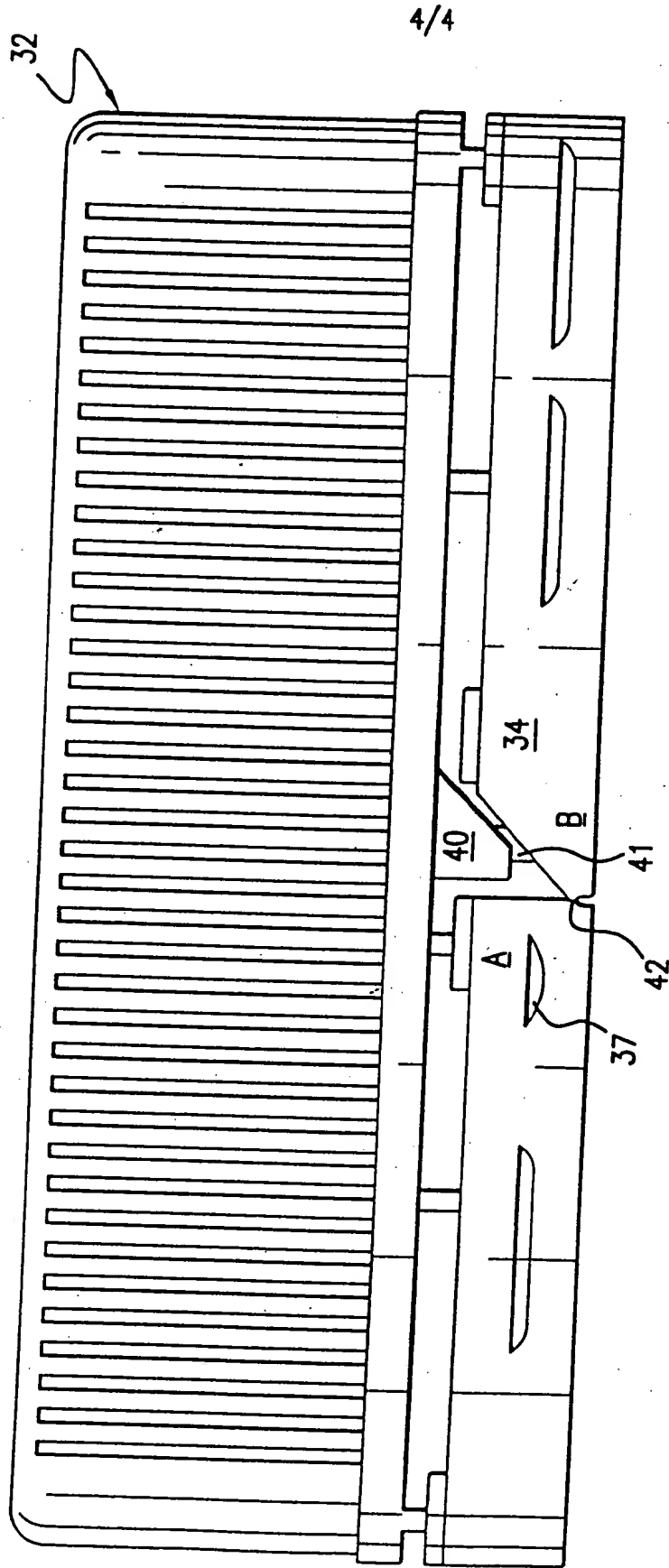


FIG.5

COPY

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL T. JENNISON, GARY MALESKI
and CARL C. SANDULLI JR.

Appeal No. 1999-1734
Application No. 08/702,272

ON BRIEF

Before FRANKFORT, NASE, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 18, which are all of the claims pending in this application. Claim 2 has been canceled.

We reverse and remand.

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THE INVENTION

The appellants' invention relates to a bracket for mounting an electrical outlet on a wall (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claim 1, the only independent claim, reads as follows:

1. A bracket for wall mounting at least one low voltage device comprising at least a tap point unit adjacent to at least one electrical receptacle, said bracket comprising a rigid border surrounding an opening sized and shaped to accept said at least one tap point unit in combination with said electrical receptacle, and further comprising alignment means located within said border at positions which permit said bracket to be aligned over said at least one electrical receptacle.

THE PRIOR ART

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Lynn

5,598,998

Feb. 4, 1997
(filed Nov. 20, 1995)

THE REJECTIONS

Claims 3 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

Claims 1 and 3 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lynn.

Reference is made to the examiner's first final rejection (Paper No. 6, mailed March 4, 1998), second final rejection (Paper No. 12, mailed November 12, 1998) and answer (Paper No. 14, mailed February 1, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 11, filed October 28, 1998), supplemental brief (Paper No. 13, filed January 12, 1999) and reply brief (Paper No. 15, filed April 1, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.¹

¹ In the present case the appellants have set forth features in the present claims which are required, pursuant to 37 CFR 1.83(a), to be shown in the drawing. Claimed features such as the tap point unit, electrical receptacle, the face plate and the receptacle box are not shown. This matter should be addressed by the appellants and the examiner during any further prosecution.

The 35 U.S.C. § 112, second paragraph, rejection

For the reasons which follow, we have determined that the examiner's rejection of claims 3 and 4 under 35 U.S.C. § 112, second paragraph, as being indefinite is not sustainable.

The examiner finds dependent claims 3 and 4 to be indefinite since the language "one other set of openings" in the dependent claims implies the existence of a first set of openings and no first set of openings has been expressly set forth in independent claim 1 (second final rejection, Paper No. 12, page 2). The appellants argue that the examiner's position is incorrect (supplemental brief, Paper No. 13, page 4).

Claims are considered to satisfy the requirements in the second paragraph of § 112 if they define the metes and bounds of the claimed subject matter with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976) and In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). In the present case, it is our view that the metes and bounds of claims 3 and 4 are sufficiently clear to enable one to evaluate the possibility of infringement and dominance as set forth in In re Hammack, *supra*. The recitation in claim 1 of an alignment means is described at page 4, lines 10-12 of the appellants' specification to mean a first

set of openings (4) located in the border (2) that mate with the screw holes in the receptacle box. This is consistent with the limitation in original claim 2 requiring "at least one first set of openings located within said border for aligning said bracket over said at least one electrical receptacle", which limitation was incorporated into amended claim 1 upon cancellation of claim 2 (Paper No. 5, filed Feb. 6, 1998). Later, the limitation was modified upon amendment of claim 1 (Paper No. 8, filed Jun. 8, 1998) to its present form wherein the phrase "alignment means" was added in place of the first set of openings. Thus, it is our view that a person having ordinary skill in the art recognizing the alignment means as providing antecedent basis for "at least one other set of openings" as recited in claims 3 and 4 would have no difficulty in determining the metes and bounds thereof with a reasonable degree of precision.

Accordingly, the decision of the examiner to reject claims 3 and 4 under 35 U.S.C. § 112, second paragraph, is reversed.

The 35 U.S.C. § 103 rejection

For the reasons which follow, we have determined that the examiner's rejection of claims 1 and 3 through 18 under 35 U.S.C. § 103(a) as unpatentable over Lynn is not sustainable.

While the examiner has not provided us with any statement of this rejection in either the final rejections (Paper Nos. 6 and 12) or the answer (Paper No. 14), we understand the rejection to be that claims 1 and 3 through 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lynn. This statement of the rejection is provided by the appellants in their statement of the issues (brief, Paper No. 11, page 4), to which the examiner responds that the statement of the issues in the brief is correct (answer, page 2).

Claim 1 is directed to a bracket and requires an alignment means located at positions which permit the bracket to be aligned over at least one electrical receptacle. It is the appellants' position that the alignment means is to be interpreted in light of the specification and that Lynn contains no teaching or suggestion that an equivalent structure exists in the prior art (brief, Paper No. 11, pages 4-5). As described by the appellants, the bracket (1) is preferably aligned over the box containing the electrical receptacle by means of at least one first set of openings (4) located in the border (2) that mate with screw holes located in the receptacle box (specification, page 4). Lynn discloses opposing tabs (18, 18') positioned against the outlet box (12) during installation (Fig. 4) as the c-shaped frame (20) encloses the outlet box (12) against the wall

stud (11) for stability (col. 3, lines 1-4). The examiner acknowledges that the openings (4) set forth in appellants' specification are the alignment means recited in the claims and argues that the use of openings as securing and alignment means would have been obvious because the use of openings for securing and alignment is common knowledge (answer, pages 4 and 5).

It is our view that Lynn does not teach or suggest the alignment means of the appellants' claim 1 nor any equivalent structure. From our perspective, the examiner has not provided any evidence of the claimed alignment means in the prior art, and we agree with the appellants that, lacking such evidence, there is no prima facie case of obviousness. We note the examiner's statement that almost all references cited in this application show the use of openings as securing and alignment means (answer, page 5), however, we are unable to find any discussion by the examiner which points to where, in the prior art references cited in this application, the use of openings as securing and alignment means is described. Moreover, there is no indication in the rejection that the examiner relied on any prior art reference other than Lynn.

With regard to the examiner's rejection of dependent claims 3 through 18, the examiner dismisses the limitations without providing any evidence that the additional limitations in these

claims are suggested or taught by the prior art (answer, page 6). A rejection based on § 103 must rest on a factual basis, which means the examiner has a duty to specify the prior art relied on and to describe where in the prior art there is a teaching or suggestion of the claimed features. The examiner may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). We find the examiner's rejection of dependent claims 3 through 18 to be without the necessary supportive evidence, thus the examiner has not met his burden of establishing a prima facie case of obviousness with respect to these claims.

For these reasons we will not sustain the examiner's rejection of claims 1 and 3 through 18 as unpatentable over Lynn.

REMAND TO THE EXAMINER

We remand this application, pursuant to 37 CFR § 1.196(e), to the examiner to consider U.S. Patent No. 5,651,696 to Jennison, which is prior art under 35 U.S.C. § 102, and Lynn. Jennison discloses a base plate (11) provided with openings (56-57) for screws for mounting to an electrical box (col. 2, lines

53-58) and for wall mounting a tap point unit (10) and at least one electrical receptacle (col. 1, lines 30-35). Jennison does not teach "an opening sized and shaped to accept said at least one tap point unit in combination with said electrical receptacle" as recited in claim 1. Lynn clearly teaches an opening sized and shaped to accept at least one tap point unit in combination with an electrical receptacle. We remand this application to the examiner to decide if it would have been obvious at the time the invention was made to a person having ordinary skill in the art to size and shape one or both of the openings (16, 17) of Jennison as suggested by Lynn. The examiner's review of the claimed subject matter and prior art should include all of the claimed subject matter in the application (claims 1 and 3 through 18) and whether such subject matter would have been obvious at the time the invention was made to a person having ordinary skill in the art, based on all of the cited prior art of record with any additional prior art the examiner may wish to consider.

Additionally, we remand this application to the examiner to determine whether claims 1 and 8 through 14 are in compliance with 35 U.S.C. § 112, second and fourth paragraphs, and 37 CFR 1.75(c). Claim 1 includes three recitations of the phrase

"electrical receptacle". The examiner should consider whether the third recitation is consistent with the other two. Specifically, the recitation of alignment means, which permits the bracket to be "aligned over said at least one electrical receptacle," appears to be inconsistent with the appellants' specification which describes a bracket (1) aligned over the electrical receptacle box containing the electrical receptacle by means of at least one first set of openings (4) located in the border (2) that mate with screw holes located in the receptacle box (specification, page 2, lines 13-15 and page 4, lines 10-12). Also, claim 1 is directed to a bracket per se and the examiner should consider whether claims 8 through 14 further limit the subject matter (bracket) of claim 1.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3 and 4 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1 and 3 through 18 under 35 U.S.C. § 103 is reversed. In addition, this application has been REMANDED to the examiner pursuant to 37 CFR § 1.196(e).

REVERSED AND REMANDED

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Appeal No. 1999-1734
Application No. 08/702,272

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